

3273-0226PUS

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Shinichi INOUE et al.

Appl. No.: 10/582,000 ART UNIT: 1796

Filed: June 7, 2006 Examiner: Liam J. Heinzer

For: RUBBER-LIKE ARTICLES AND RUBBER-LIKE MATERIAL-  
CONTAINING ARTICLES

DECLARATION UNDER 37 C.F.R. 1.132

Assistant Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

I, Tomohiro Nishio, a citizen of Japan and residing at 511 Nishinosawa, Iga, Mie, Japan, declare and state that:

I completed Master's course in Engineering, Graduate school of Engineering, Aichi Institute of Technology.

I joined NITTA CORPORATION in April, 1999 and have been engaged in research and development of rubber products up to the present date.

I am a member of:  
The Chemical Society of Japan;  
The Society of Polymer Science, Japan; and  
The Society of Rubber Industry, Japan.

I am one of the inventors of the above-identified application and am familiar with the subject matter thereof.

I have read the Official Action notified on June 5, 2009 and the references cited therein and am familiar with the subject matter thereof.

I declare that the statement below is true to the best of my knowledge.

STATEMENT:

Further discussions about the patentability of the present application

Undue experimentation is needed for completion of the present invention

As the Examiner pointed out, natural rubber is described in the cited reference as one example of various kinds of rubbers. Although the application of MPEP §2123 is understandable, as described before, the effects caused by the natural rubber as one kind of many miscellaneous rubbers disclosed therein should not have been predictable at all before the present invention. In order to confirm these effects, it is necessary to spend a great amount of time and cost. Accordingly, even if there is a mere description in the prior art, one cannot complete the present invention because an excessive experiment is needed to confirm an unpredictable result. Therefore, the inventive step of the present invention cannot be denied by only assuming grounds described in the example.

The Examiner asserts that a series of process including performing experiments on seven kinds of rubbers, selecting appropriate rubber and completing the present invention is not considered as an undue experimentation, and that the process is a routine common art of those skilled in the art. However, we disagree with this assertion and believe that such a work should be considered an undue experimentation.

Assuming that the rubber product according to the present invention is completed after the experiments as described in example 1 and physical properties evaluation 1-3, and the examination of the rubber described in the cited reference, since seven kinds of rubber products must be manufactured and be examined, seven examinations would be necessary. Moreover, it would be necessary to secure twice the time in practice considering the possible errors by the machine and/or operator.

Considering the above, the time required to manufacture and examine seven kinds of rubber products would be at least about ten times more than the time required for one kind of rubber product.

In addition, it is clear that the necessary cost becomes huge as well.

Reduction of costs is an important and inevitable issue for the companies in today's global recession. Such amount of time and the cost are not considered a routine business, and are recognized as an excessive experiment from Applicant's standpoint.

I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing thereon.

This 7th day of October, 2009

Tomohiro Nishio  
Tomohiro NISHIO